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Gerald Isaac Kestenbaum

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GERALD ISAAC KESTENBAUM

Appeal 2009-012277
Application 09/587,525
Technology Center 3600

Before HUBERT C. LORIN, JOSEPH A. FISCHETTI, and
MEREDITH C. PETRAVICK, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Gerald Isaac Kestenbaum (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 98-100 and 102-160. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM-IN-PART.¹

THE INVENTION

This invention is “an apparatus and a method for providing building management services.” Spec. 1:4-8.

Claim 98, reproduced below, is illustrative of the subject matter on appeal.

98. A collaborative real estate management system for exchanging information among tenants and an individual associated with management of a building, the system comprising:
a computer system in communication with data input and output devices accessible by said tenants and said individual associated with management of said building;
said computer system including one or more processors networked together and programmed to process data relating to management of said building;

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Jul. 25, 2008) and Reply Brief (“Reply Br.,” filed Dec. 29, 2008), and the Examiner’s Answer (“Ans.,” mailed Oct. 23, 2008).

said one or more processors being further programmed i) to receive a communication relating to management of said building from a device associated with at least one of said tenants, said communication including data indicating an instruction being associated with a task performed by said individual, said individual being associated with a front desk of said building, a front gate of said building, or a combination thereof, ii) to associate said instruction with said at least one of said tenants using an identifier, iii) to store said instruction and said identifier on said computer system, and iv) to enable said individual to search said computer system to obtain said instruction using a computing device associated with said individual,

wherein said computer system enables interaction by said tenants with said individual through said system.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Strait	US 6,038,315	Mar. 14, 2000
Abe	JP 0809850 A	Apr. 12, 1996
Aihara	JP 410229413 A	Aug. 25, 1998

Yahoo! Home Page, <http://www.yahoo.com> (last visited Nov. 1, 2006)

The Examiner took Official Notice that “it is old an[d] known at the time of invention to one of ordinary skill in the art that [a] building supervisor (aka super) associated with the real estate management who took care of tenant needs lived in the building as a tenant (at least in New York City.) Tenants communicated with super for services like repairs associated with the apartment.” Ans. 4. [Hereinafter, Official Notice I.]

The Examiner states “[i]t is old an[d] known that an apartment complex can have [a] plurality of buildings.” Ans. 9 [Hereinafter, Official Notice II.]

The following rejections² are before us for review:

1. Claims 98-100, 102-111, 113-118, 121-134, 139-143, 159, and 160 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II.
2. Claims 112 and 136 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Abe.
3. Claims 119 and 120 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Strait.
4. Claims 135, 137, 138, and 144-156 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Yahoo.com.
5. Claims 157 and 158 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, Yahoo.com and Strait.

² In the Appeal Brief, the Appellant includes arguments directed to the rejection of claim 121 under 35 U.S.C. § 112, first paragraph and the rejection of claims 112 and 136 under 35 U.S.C. § 112, second paragraph. App. Br. 7-8 and 10-15. However, these rejections were not included in the Final Rejection mailed January 25, 2008 and therefore, seem to have been withdrawn by the Examiner. *See* Ans. 18 and Reply Br. 1.

ISSUES

The first issue is whether claims 98-100, 102-111, 113-118, 121-134, 139-143, 159, and 160 are unpatentable under 35 U.S.C. § 103(a) over Aihara and Official Notice I-II.

The second issue is whether claims 112 and 136 are unpatentable under 35 U.S.C. § 103(a) over Aihara, Official Notice I-II, and Abe. Specifically, the major issue is whether the Examiner established a prima facie showing of obviousness in rejecting claim 112.

The third issue is whether claims 119 and 120 are unpatentable under 35 U.S.C. § 103(a) over Aihara, Official Notice I-II, and Strait. Specifically, the major issue is whether the Examiner established a prima facie showing of obviousness in rejecting claims 119 and 120.

The fourth issue is whether claims 135, 137, 138, and 144-156 are unpatentable under 35 U.S.C. § 103(a) over Aihara, Official Notice I-II, and Yahoo.com. Specifically, the major issue is whether the Examiner established a prima facie showing of obviousness in rejecting claim 135 and 146. The rejection of claims 157 and 158 as unpatentable under 35 U.S.C. § 103(a) over Aihara, Official Notice I-II, Yahoo.com and Strait also turn on this issue.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. The Specification does not contain an express definition of “instruction.”
2. An ordinary and customary meaning of “instruction” is “a direction calling for compliance.” (*See Merriam-Webster’s Collegiate Dictionary* 606 (10th Ed. 1998.)(Second entry for “instruction.”)

ANALYSIS

The rejection of claims 98-100, 102-111, 113-118, 121-134, 139-143, 159, and 160 under § 103(a) as being unpatentable over Aihara and Official Notice I-II

Claims 98, 102, 105, 108-109, 111, 113-115, 132 -134, and 159-160

The Appellant argued 98, 102, 105, 108-109, 111, 113-115, 132 -134, and 159-160 as a group. App. Br. 8 and 15-22. We select claim 98 as the representative claim for this group, and the remaining claims 102, 105, 108-109, 111, 113-115, 132 -134, and 159-160 stand or fall with claim 98. 37 C.F.R. § 41.37(c)(1)(vii) (2010).

We are not persuaded by the Appellant that the Examiner erred in finding claim 98 unpatentable under 35 U.S.C. § 103(a) over Aihara and Official Notice I-II. The Appellant has made several arguments to traverse the rejection of claim 98 and we will address each one in turn.

Turning to the Appellant’s first argument, the Appellant argues that the combination of Aihara and Official Notice I-II does not teach all of the limitations recited in claim 98. *See* Ans. 15-18. Specifically, the

Appellant's argument focuses on the instructions recited in claim 1. Ans.

17. The Appellant argues that:

[T]he Applicant claims a collaborative system in which a communication is received. The communication includes data indicating an *instruction* and that *instruction* is associated with a *task* that is performed by an individual associated with the front desk and/or front gate. Further, the claim requires that the *instruction*, not the communication, be associated with a tenant via an identifier and the *instruction*, not the communication be stored with the identifier on the computer system. . . This is not merely a "type of content" of an email. An email message is a free-form type of communication that can be presented in whatever fashion the sender would like to construct it. In contrast, an instruction is a structured form with which the collaborative system can associated other data and store appropriately.

App. Br. 17 (emphasis original).

We find this argument unpersuasive as it is not commensurate with the scope of claim 98. First, we note that claim 98 is directed to an apparatus and the limitation at issue is directed to the structure of the processor. The processor has a structure that is programmed "to receive a communication," "to associate," and "to store." We fail to see how the structure of a processor that is programmed to *receive* is different from that of the prior art based on the data included in the received communication and the Appellant does not direct their argument to the structure of the processor (*see Id.*)

Second, the Appellant seems to argue that the claim precludes the processor from being programmed to associate the communication (i.e.,

Aihara's email), as well as the instruction (i.e., content of email), being associated with a tenant via an identifier (i.e., tenant's email address). App. Br. 17. We see nothing that precludes this or precludes the instruction being associated with a tenant's identifier by being included in the same email.

Third, the Appellant seems to argue that the claim 98 precludes the communication from being stored by the processor as well as the instruction. App. Br. 17. Again, we see nothing that precludes this or precludes the instruction being store with the identifier by storing the email.

Further, as to the Appellant's argument that "an instruction is a structured form with which the collaborative system can associate other data and store appropriately" (App. Br. 17), we see nothing in claim 98 that restricts the claimed "instruction" to this definition argued by the Appellant. The Appellant has not acted as their own lexicographer and provided an expressed definition in the Specification (FF 1) nor is this required by the ordinary and customary meaning of the term "instruction" (*see* FF 2). During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004). "[W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984).

Also, the Appellant attempts to argue for a narrow reading of the meaning of "instruction" recited in claim 98 by importing limitations from claim 113 and 114. Ans. 17-18. We fail to see how limitations recited in

claims 113 and 114 narrow the meaning of terms in claim 98. Further, we note that claims 113 and 114 do not depend from claim 98.

Turning to the Appellant's second argument, the Appellant argues that the prior art itself does not include a suggestion of the proposed modification and, therefore, the Examiner has applied impermissible hindsight in rejecting claim 98. App. Br. 18-19. The Appellant's position is not in accord with the law on obviousness. "The motivation need not be found in references sought to be combined, but may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself." *Dystar Textlifarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). "There is no requirement that the prior art contain an express suggestion to combine known elements to achieve the claimed invention." *Motorola, Inc. v. Interdigital Tech. Corp.*, 121 F.3d 1461, 1472 (Fed. Cir. 1997).

Finally, turning to the Appellant's third argument, the Appellant's argument that the Declaration of Gerald I. Kestenbault filed Jun. 1, 2004, the Letter from Illya Shell filed Jun. 1, 2004, the Letter of Jerry Morris filed Jun. 1, 2004, and the Letter of Martin Astrof filed Jun. 1, 2004 are evidence of secondary considerations of patentability. Specifically, of long felt need and commercial success. App. Br. 19-21. However, we do not find them adequate to overcome the prima facie showing of obviousness established by the Examiner.

Objective evidence of nonobviousness, including commercial success, must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791, 791 (CCPA 1971). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to

unclaimed features. *Joy Techs. Inc. v. Manbeck*, 751 F. Supp. 225, 229 (D.D.C. 1990), *aff'd*, 959 F.2d 226, 228 (Fed. Cir. 1992) (Features responsible for commercial success were only recited in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.) An inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996).

First, we note that the Declaration of Gerald I. Kestenbault and the three Letters are directed to differences between the claimed invention and a prior art system BJ Murray which is no longer used to reject the claims. Second, none of the submitted references establish a nexus between the claimed features and the purported commercial success or the long felt need.

For the reasons given above, we are not persuaded by the Appellant that the Examiner erred in rejecting claim 98 under 35 U.S.C. § 103(a). Accordingly, the rejection of claims 98, 102, 105, 108-109, 111, 113-115, 132 -134, and 159-160 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is affirmed.

Claim 99

We are not persuaded by the Appellant's argument that the Examiner erred in rejecting claim 99 because the data storage means of Aihara, cited by the examiner (Ans. 6) is not a database for storing information about the users of the system as is describe in a preferred embodiment of the Specification (App. Br. 22). This limitation is not required by claim 99. Claim 99 merely recites "said computer system includes a database."

Further, as with the rejection of claim 98 above, the Appellant argues secondary consideration. App. Br. 22. For the reasons discussed above with regards to claim 98, we find this argument unpersuasive.

Accordingly, we affirm the rejection of claim 99 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II.

Claim 100

We are persuaded by the Appellant's argument that the Examiner erred in rejecting claim 100 (*see* App. Br. 23). While the Examiner argues that the data storage means of Aihara has a structure to be capable of storing emails. *See* Ans. 6. The claims also require that the claimed database has a structure that is allows access to the documents (i.e. emails) for viewing and editing by the tenants, a staff member, etc. The Examiner does not address this portion of the limitation. *See Id.* Accordingly, we find that the Examiner has failed to establish a *prima facie* showing of obviousness, and we reverse the rejection of claim 100.

Claim 103

We are not persuaded by the Appellant's argument that the Examiner erred in rejecting claim 103 because Aihara does not teach receiving a communication relating to package delivery and pickup information. App. Br. 23-24. As discussed above with regards to claim 98, claim 103 is directed to structure of the processor. The processor has a structure that is programmed "to receive a communication." We fail to see how the structure of a processor that is programmed to *receive* is different from that of the prior art based on the data included in the received communication and the

Appellant does not direct their argument to the structure of the processor (*see Id.*) Therefore, we find this argument unpersuasive.

Further, as with the rejection of claim 98 above, the Appellant argues that the Examiner has applied impermissible hindsight and secondary consideration. App. Br. 24. For the reasons discussed above with regards to claim 98, we find this argument unpersuasive.

Accordingly, the rejection of claim 103 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is affirmed.

Claim 104

We are not persuaded by the Appellant's argument that the Examiner erred in rejecting claim 104 because Aihara does not teach receiving and responding to survey questions from the management of the building. App. Br. 24. As discussed above with regards to claim 98, claim 103 is directed to structure of the processor. The processor has a structure that is programmed "to receive a communication." We fail to see how the structure of a processor that is programmed to *receive* is different from that of the prior art based on the data included in the received communication and the Appellant does not direct their argument to the structure of the processor (*see Id.*) Therefore, we find this argument unpersuasive.

Further, we note that "responding to survey[] question" is not recited in claim 104. Instead, claim 104 recites "said one or more processors are further programmed to receive . . . a response to said survey questions."

Again, as with the rejection of claim 98 above, the Appellant argues that the Examiner has applied impermissible hindsight and secondary

consideration. App. Br. 24-25. For the reasons discussed above with regards to claim 98, we find this argument unpersuasive.

Accordingly, the rejection of claim 104 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is affirmed.

Claim 106

We are not persuaded by the Appellant's argument that the Examiner erred in rejecting claim 106 because Aihara does not teach that the database includes addresses and contact information for tenants, a staff member, or a building manager. App. Br. 25.

First, the Appellant merely asserts that "Aihara does not teach or suggest maintaining a database of contact information for the management and tenants." App. Br. 25.

Again, as with the rejection of claim 98 above, the Appellant argues that the Examiner has applied impermissible hindsight and secondary consideration. App. Br. 24-25. For the reasons discussed above with regards to claim 98, we find this argument unpersuasive.

Accordingly, the rejection of claim 106 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is affirmed.

Claim 107

We are not persuaded by the Appellant's argument that the Examiner erred in rejecting claim 107 because it is not commensurate with the scope of the claim. The Appellant argues that Aihara does not teach or suggest a database for task tracking, because "[t]ask tracking requires including state information about the task. The Examiner seems to totally ignore this claim

requirement.” App. Br. 25. However, claim 107 merely recites “wherein said database includes information for task tracking.” Claim 107 does not specify that the information is state information.

Again, as with the rejection of claim 98 above, the Appellant argues that the Examiner has applied impermissible hindsight and secondary consideration. App. Br. 26. For the reasons discussed above with regards to claim 98, we find this argument unpersuasive.

Accordingly, the rejection of claim 107 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is affirmed.

Claim 110

We are persuaded by the Appellant’s argument (App. Br. 26-27) that the Examiner erred in rejecting claim 110.

In the rejection, the Examiner reasons that “Aihara is capable of handling a message that includes instructions like permission to give access to a unit associated with a tenant, package delivery.” Ans. 7. However, claim 110 is directed to a method and not an apparatus. Claim 110 requires that the “instruction is associated with permission to give access to a unit associated with said tenant, key-holding information, or any combination thereof.” The Examiner has not established that this step as required by claim 110 is taught by Aihara. Therefore, we find that the Examiner has failed to establish a prima facie showing of obviousness. We note that the Examiner does not rely upon Official Notice I-II to cure this deficiency of Aihara.

Accordingly, the rejection of claim 110 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is reversed.

Claims 116-118

We are persuaded by the Appellant's argument (App. Br. 26-27) that the Examiner erred in rejecting claims 116.

In the rejection, the Examiner reasons that "Aihara teaches capability for transmitting data representing portion of first instruction." Ans. 8. However, claim 116 is directed to a method and not an apparatus. Claim 116 requires a step of "transmitting data representing said first instruction, a portion of said first instruction, said identifier, or any combination thereof to a public display." The Examiner has not established that this step as required by claim 116 is taught by Aihara. Therefore, we find that the Examiner has failed to establish a prima facie showing of obviousness. We note that the Examiner does not rely upon Official Notice I-II to cure this deficiency of Aihara.

Claim 118 recites a similar step and for the same reasons we find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 118. Accordingly, the rejection of claims 116 and 118, and claims 117, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is reversed.

Claim 121

We are persuaded by the Appellant's argument (App. Br. 28) that the Examiner erred in rejecting claim 121. We agree. In the rejection, the Examiner reasons that:

Aihara teaches using LAN/intranet to
interconnect [a] plurality of user devices. It is old

an[d] known that an apartment complex can have [a] plurality of buildings. Therefore, Aihara teaches capability for providing aggregated data for said first building and a second building (intranet, plurality of buildings.

Ans. 9.

Claim 121 is directed to a method and requires a step of “providing aggregated data for said first building and said second building.” The Examiner rejection is overly conclusory and does not establish that these steps are taught by Aihara. *See* Ans. 9. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Therefore, we find that the Examiner has failed to establish a prima facie showing of obviousness. We note that the Examiner does not rely upon Official Notice I-II to cure this deficiency of Aihara.

Accordingly, the rejection of claim 121 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is reversed.

Claims 122-131

We are persuaded by the Appellant’s argument (App. Br. 28-29) that the Examiner erred in rejecting claim 122.

Again, claim 122 is directed to a method and recites three steps that include a request for service, a second individual, and a second tenant. The Examiner rejection is overly conclusory and does not established that this step would have been obvious over Aihara and Official Notice II

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 122. Accordingly, the rejection of claim 122, and claims 123-131, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is reversed.

Claims 139-143

Claims 139-143 are indirectly dependent upon claim 135, which the Examiner rejected under 35 U.S.C. § 103(a) over a combination of Aihara, Official Notice I-II with Yahoo.com. The Examiner cited the Yahoo.com reference to teach the limitation recited in claim 135. The Yahoo.com reference is missing from the rejection of claims 139-143. Therefore, we find that the Examiner has not established a prima facie showing of obviousness in rejecting claims 139-143 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II. Further, we note that the rejection of claim 135 under 35 U.S.C. § 103(a) over a combination of Aihara, Official Notice I-II with Yahoo.com is reversed below.

Accordingly, the rejection of claims 139-143 under 35 U.S.C. § 103(a) as being unpatentable over Aihara and Official Notice I-II is reversed.

The rejection of claims 112 and 136 under § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Abe

Claim 112

We are persuaded by the Appellant's argument (App. Br. 31-32) that the Examiner erred in rejecting claim 112. The Examiner's rejection is overly conclusory and does not established that a step of "designating said instruction as being inactive upon expiration of a specified time period" would have been obvious over Aihara, Official Notice I-II, and Abe. We note that the Examiner does not cite to any particular section of Abe to teach this step (*see* Ans. 13) or respond to the Appellant's argument. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We find that the Examiner has failed to establish a *prima facie* showing of obviousness in rejecting claim 112. Accordingly, the rejection of claim 112 under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Abe is reversed.

Claim 136

Claim 136 is dependent upon claim 135, which the Examiner rejected under 35 U.S.C. § 103(a) over a combination of Aihara, Official Notice I-II with Yahoo.com. The Examiner cited the Yahoo.com reference to teach the

limitation recited in claim 135. The Yahoo.com reference is missing from the rejection of claim 136. Therefore, we find that the Examiner has not established a prima facie showing of obviousness in rejecting claim 136 under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Abe. Further, we note that the rejection of claim 135 under 35 U.S.C. § 103(a) over a combination of Aihara, Official Notice I-II with Yahoo.com is reversed below.

Accordingly, the rejection of claim 136 under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Abe is reversed.

The rejection of claims 119 and 120 under § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Strait

Claims 119 and 120

We are persuaded by the Appellant's argument (App. Br. 34-35) that the Examiner erred in rejecting claim 119. Further, we note that the Examiner's rejection is overly conclusory and does not established that a step of "receiving biometric data" would have been obvious over Aihara, Official Notice I-II, and Strait. We note that the Examiner does not cite to any particular section of Strait to teach this limitation (*see* Ans. 13-14) nor does the Examiner respond to the Appellant's argument.

We find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 119. Accordingly, the rejection of claim 119, and claims 120, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Strait is reversed.

The rejection of claims 135, 137, 138, and 144-156 under § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Yahoo.com

Claims 135, 137, 138 and 144-156

We are persuaded by the Appellant's argument (App. Br. 34-35) that the Examiner erred in rejecting claim 135. We agree with the Appellant that the Examiner did not meet the burden of establishing a prima facie showing of obviousness. Again, the Examiner's rejection is overly conclusory and does not established that a step of "providing an electronic library including one or more electronic documents" would have been obvious over Aihara, Official Notice I-II, and Yahoo.com. We note that the Examiner does not cite to any particular portion of Yahoo.com to teach this limitation (*see* Ans. 14) nor does the Examiner respond to the Appellant's argument regarding the teachings of Yahoo.com

We find that the Examiner has failed to establish a prima facie showing of obviousness in rejecting claim 135. Claim 146, which does not depend from claim 135, recites a similar limitation and was similarly rejected. Accordingly, the rejection of claims 135 and 146, and claims 137, 138, 144, 145, and 147-1256, dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, and Yahoo.com is reversed.

The rejection of claims 157 and 158 under § 103(a) as being unpatentable over Aihara, Official Notice I-II, Yahoo.com, and Strait

Claims 157 and 158

This rejection is directed to claims dependent on claim 148, whose rejection we have reversed above. For the same reasons, we will not sustain the rejections of claims 157 and 158 over the cited prior art. *Cf. In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) ("[D]ependent claims are nonobvious if the independent claims from which they depend are nonobvious.")

Accordingly, the rejection of claims 157 and 158, under 35 U.S.C. § 103(a) as being unpatentable over Aihara, Official Notice I-II, Yahoo.com, and Strait is reversed.

DECISION

The decision of the Examiner to reject claims 98, 99, 102-109, 111, 113, 114, 115, 119, 120, 132-134, 159-160 is affirmed and to reject claims 100, 110, 112, 116-118, 121-131, and 135-158 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED-IN-PART

JRG